

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Robert CHASSAGNON et al.
Serial No.: 10/578,119
Filed: May 1, 2006
For: Tread for Pneumatic Tires

Examiner: Scott, Angella C
Group Art: 1796

Confirmation #: 5029

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR A PRE-APPEAL BRIEF REVIEW

SIR:

This is a Request for a Pre-Appeal Brief Review ("Request") seeking a panel review of issues on appeal in the above-referenced application. The present Request is filed concurrently with a Notice of Appeal and is filed before an Appeal Brief. The Notice of Appeal and Request are filed in response to the final Office Action dated March 16, 2010. Applicants have previously submitted an Amendment on August 11, 2010 and a Response to Notice of Non-Compliant Amendment (due to missing of claim 19, which has been cancelled, from the listing of claims) on September 1, 2010 in response to the final Office Action. Examiner Scott informed the undersigned attorney during a telephone communication on September 14, 2010 that she would enter Applicants' amendments to the claims after final, maintain the rejection of all the pending claims, and issue a formal Advisory Action. As of September 15, 2010, Applicants have not received the formal Advisory Action.

REMARKS/ARGUMENTS

The matter to be reviewed is: whether under 35 U.S.C. §103(a), currently pending claims 1, 4-10, 13, 14, 20 and 21 are patentable over Hopkins (US 2002/0198305) in view of Vasseur (WO 02/088238) and Simonot (US2004/0030017). (For convenience, the citations below for Vasseur are from its English language equivalent US 2004/0127617.)

For reasons expressed below, claim 1 and the remaining pending claims, which all depend from claim 1, are not obvious over Hopkins in view of Vasseur and Simonot under 35 U.S.C. §103(a).

Independent claim 1 recites a **passenger car tire** comprising a tread. The tread comprises a rubber composition, which comprises a diene elastomer, silica in an amount of greater than 50 phr, a coupling agent, and a plasticising agent. The diene elastomer comprises a **styrene butadiene rubber copolymer and 40 to 80 phr of butyl rubber. The plasticising agent comprises 10 to 50 phr of an unsaturated (C₁₂-C₂₂) fatty acid triester of glycerol.**

(i)

The primary reference Hopkins is clearly directed to (among applications other than tires) tire tread of heavy vehicles, such as trucks and buses. See paragraphs 0002 and 0084, and claims 11-13 of Hopkins. Nowhere does Hopkins mention that the elastomeric composition disclosed therein can be used for a passenger car tire. Therefore, a modification of Hopkins based on Vasseur and Simonot as proposed by the Examiner would not produce the invention of claim 1 and its dependent claims, which are directed to **a passenger car tire**.

The Examiner argues as follows: "Hopkins teaches that its composition is used in tire tread compositions for vehicles. A passenger car is a type of vehicle. While Hopkins goes on to say that it is especially useful for tire tread of trucks and buses, it does not exclude other types of vehicles." See the Office Action, page 4, second full paragraph. This argument lacks merit.

The fact that Hopkins does not exclude tires for types of vehicles other than trucks and buses is not sufficient in concluding that Hopkins discloses tires for passenger cars. For a reference to disclose a claimed feature under 35 U.S.C. §§ 102 and 103, the reference must positively disclose the claimed feature either expressly or implicitly or inherently. See, e.g., MPEP 2112. Here, nowhere does Hopkins disclose a passenger car tire, nor can the Examiner identify any passage in Hopkins that discloses a passenger car tire expressly, implicitly, or inherently.

It is well settled law that a reference, which discloses a genus encompassing a claimed species without specifically disclosing the claimed species, cannot be relied on as disclosing the claimed species. *See, e.g.,* MPEP 2144.08. (“When a single prior art reference which discloses a genus encompassing the claimed species or subgenus but does not expressly disclose the particular claimed species or subgenus, Office personnel should attempt to find additional prior art to show that the differences between the prior art primary reference and the claimed invention as a whole would have been obvious.”) Therefore, by merely disclosing the genus “vehicles”, Hopkins cannot be relied on as disclosing the species “passenger car.”

Moreover, as explained below in more detail, the requirements for heavy vehicles, such as trucks and buses, which are expressly disclosed in Hopkins, are substantively different from the requirements for light vehicles, such as passenger cars, which are not disclosed by Hopkins in any manner. Therefore, there is no basis for a person of ordinary skill in the art to conclude that the teachings in Hopkins, which are specifically directed to tires for heavy vehicles, will be equally applicable to passenger car tires.

The Examiner also argues: “Moreover, in paragraph 2 of Hopkins, desirable properties of a vehicle tire, such as good wet traction, good wear characteristics, and low rolling resistance, are listed and it is noted that these are desirable properties for all vehicle tires, not just tires for trucks and buses.” *See* the Office Action, page 4, second paragraph. This argument misses the point. At paragraph 2, Hopkins explains, **“Many properties are desirable in a rubber used in a vehicle tire tread and generally improvements in one property are achieved at the expense of other properties.”** (Emphasis added.) Different types of vehicles have different specific requirements for various desired properties, such as grip performance and wear characteristics. Because improvements in one property are achieved at the expense of other properties, a vehicle tire cannot have all the desired properties at their best. In other words, there must be some compromises among the many desired properties. But one type of vehicle tire may tolerate certain compromised desired property more than another different type of vehicle. Therefore, absent any apparent reason, a person of ordinary skill in the art would not modify the tire treads of Hopkins, which are designed for trucks and buses, based on the relevant teachings of Vasseur and Simonot, which are all directed to tire treads for passenger cars. In fact, a person of ordinary skill in the art would be discouraged to do so due to the concern that improving one

property of a heavy vehicle tire tread based on the teachings concerning a light vehicle tire tread may render another property of the heavy vehicle tire tread unacceptable.

(ii)

Hopkins is directed to a **heavy** vehicle running at a **low** speed.

Vasseur is directed to a **light** passenger vehicle running at a **high** speed. Similarly, the relevant teachings of Simonot concerning the use of SBR (i.e., paragraph 0082 of Simonot), which are relied upon by the Examiner, are also directed to a **light** passenger vehicle running at a **high** speed.

There is no apparent reason for a person of ordinary skill in the art to add unsaturated (C₁₂-C₂₂) fatty acid triester of glycerol to Hopkins' tire tread composition, based on Vasseur, which is directed to a **light** passenger vehicle running on roads at a **high** speed, to improve the grip of Hopkins' tire, which is directed to a **heavy** vehicle running at a **low** speed.

Vasseur is directed to tires of a passenger car, which is apparently designed for running on roads at a very high speed. *See* paragraph 0002. There is a need to improve the grip of tires of a passenger car on dry or damp ground. *See* paragraph 0005.

On the other hand, as stated above, Hopkins is directed to tires of a heavy vehicle, which is designed to run at a much lower speed compared to a light passenger car. Due to its much lower speed and heavier weight compared to a light passenger car, a heavy vehicle does not have the same concern or demand for high grip ability, as does a light passenger car in Vasseur. Indeed, as evidenced by Sandstrom, which was previously cited by the Examiner, it is well known that heavy vehicles rely more on their weight to provide tire tread traction over the ground, in contrast to passenger tires. Neither Hopkins nor Vasseur teaches, discloses or suggests any need to improve the grip ability of the tire of a heavy vehicle. In fact, as noted above, improving the grip ability of the tire of a heavy vehicle may render other properties of the tire of the heavy vehicle unacceptable.

Therefore, the references cited by the Examiner provide no apparent reason for a person of ordinary skill in the art to add unsaturated (C₁₂-C₂₂) fatty acid triester of glycerol, which is used in Vasseur for a light passenger vehicle running at a high speed, to Hopkins' tire tread composition for a heavy vehicle running at a much lower speed.

Nor is there any reason for a person of ordinary skill in the art to substitute a blend of SBR and butadiene rubber in Simonot for the natural rubber of Hopkins, as proposed by the Examiner. *See* the Office Action, page 3, second full paragraph. As stated by the Examiner, Simonot teaches that an SBR and butadiene rubber blend is desirable for passenger car tires. But Hopkins, as stated above, discusses tire treads for trucks and buses, not passenger cars.

(iii)

Due to the significant differences concerning the composition and requirements of Hopkins and Vasseur (or Simonot), a person of ordinary skill in the art would not have any reasonable expectation of success to simply add one ingredient disclosed in Vasseur (or Simonot) to another significantly different tire composition for a different type of vehicle as disclosed in Hopkins. Nor would s/he reasonably expect that doing so would not in actuality adversely affect or interfere with some critical properties of Hopkins' heavy vehicle tire treads.

(iv)

The unexpected results as shown at paragraphs 0122-0140 of the present published application further indicate that the invention as described in the claims of the present application is not obvious over Hopkins in view of Vasseur and Simonot. As explained at, e.g., paragraph 0006 of the present published application, the grip of the tire as described in the claims of the present application on wet ground is significantly increased. This unexpected result is further demonstrated by the comparative test results described at paragraphs 0122-0140 of the present published application.

For at least the reasons expressed above, claim 1 and the remaining pending claims 4-10, 13, 14, 20 and 21, each of which depends from claim 1, are not obvious under 35 U.S.C. §103(a). Reversal of the Examiner's decision is respectfully requested.

Respectfully submitted,
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Dated: September 16, 2010